

REMARKS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 2, 5-8, 11-14, 22, 25-28, 31-34, and 41-47 have been cancelled. No claims have been added. Claims 1, 3-4, 9-10, 15-21, 23-24, 29-30, and 35-40 have been amended. Hence, Claims 1, 3-4, 9-10, 15-21, 23-24, 29-30, and 35-40 are pending in the application.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 5, 11, 13 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to point out and distinctly claim the subject matter which the Applicant regards as the invention. In this paper, Claims 5, 11, and 13 have been cancelled. Consequently, it is respectfully submitted that the rejection under 35 U.S.C. § 112, second paragraph has been rendered moot.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. §102(b)

Claims 1-47 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by WO 99/26415 by Bar-el ("Bar-El"). Applicant has amended the pending claims to more distinctly claim subject matter to which the Applicant regards as the invention.

The pending claims are patentable over the cited art as each features at least one element that is not disclosed, taught, or suggested by the cited art.

Claim 1 recites:

“at said media server, receiving a first request for specified content from a first user, wherein said specified content includes data representing an original series of frames of digital information ;
consulting a first user profile associated with said first user;
determining the composition of a first digital data stream to send to said first user from said media server based upon said first user profile and said specified content;
constructing said first customized digital data stream, where the step of constructing said first customized digital data stream includes performing at least one of:

removing, from said original series of frames, one or more frames,
wherein said removed frames are selected based on said
first user profile,
modifying audio information, associated with one or more of said
original series of frames, based on said first user profile,
and
inserting additional frames of video, into said original series of
frames, based on said first user profile, wherein said
additional frames of video do not modify any frame in the
original series of frames;
sending said first customized digital data stream from said media server to
said first user;
at said media server, receiving a second request for said specified content
from a second user;
consulting a second user profile associated with said second user;
determining the composition of a second digital data stream to send to said
second user from said media server based upon said second user
profile and said specified content;
constructing said second customized digital data stream, where the step of
constructing said second customized digital data stream includes
performing at least one of:
removing, from said original series of frames, one or more frames,
wherein said removed frames are selected based on said
second user profile,
modifying audio information, associated with one or more of said
original series of frames, based on said second user profile,
and
inserting additional frames of video, into said original series of
frames, based on said second user profile, wherein said
additional frames of video do not modify any frame in the
original series of frames; and
sending said second customized digital data stream from said media server
to said second user,
wherein said first customized digital data stream is different than said
second customized digital data stream (emphasis added).”

The above-quoted combination of elements of Claim 1 is not disclosed, taught, or
suggested by *Bar-El*.

Both the approach of the pending claims and *Bar-El* are directed towards
delivering customized video to a user. However, beyond this broad generality, there are
significant distinctions between the approach featured in the pending claims and that of
Bar-El.

In the approach of *Bar-El*, in response to receiving a request for video, a user profile is consulted, a personalized image may be inserted into an existing frame of video in a video stream, and the video stream is delivered to the requestor. Importantly, to the extent that *Bar-El* discusses modifying a video stream based on information stored in a user profile, that modification is limited to implanting images into existing frames of video. For example, FIG. 2 shows a system where a soccer ball 36 on wall 35 may be implanted on a frame of digital video for a first user, and a drink bottle 34 may be implanted into the same frame of video for a second user (See FIG. 2, page 7, line 20 – page 13, line 2).

In sharp contrast, Claim 1 features “constructing said first customized digital data stream, where the step of constructing said first customized digital data stream includes performing at least one of ...inserting additional frames of video, into said original series of frames, based on said first user profile, wherein said additional frames of video do not modify any frame in the original series of frames.” *Bar-El* lacks any discussion of inserting additional frames of video into the original series of frames of the requested specified content that do not modify any frame of the original series of frames of the requested specified content. In the approach of *Bar-El*, no frames are inserted into the original series of frames that are requested, as the user receives the exact original series of frames that the user requested, although one or more of the requested original series of frames may have an image implanted into the frame. Consequently, this element is not disclosed, taught, or suggested by *Bar-El*.

Further, *Bar-El* lacks any suggestion of “removing, from said original series of frames, one or more frames, wherein said removed frames are selected based on said first user profile” or “modifying audio information, associated with one or more of said original series of frames, based on said first user profile” as featured in Claim 1. No portion of *Bar-El* contains a suggestion of (a) removing one or more frames from the original series of frames that were requested, or (b) modifying audio information associated with the original series of frames that were requested. Thus, the elements of “constructing said first customized digital data stream” and “constructing said second customized digital data stream” are not disclosed, taught, or suggested by *Bar-El* in view of the identified differences discussed above.

At least one element featured in Claim 1 is not disclosed, taught, or suggested by *Bar-El*. Consequently, it is respectfully submitted that, for at least the reasons given above, Claim 1 is patentable over the cited art and is in condition for allowance.

Claim 21 recites features similar to that of Claim 1, except in computer-readable medium format. Consequently, it is respectfully submitted that, for at least the reasons given above, Claim 21 is patentable over the cited art and is in condition for allowance.

Claims 3-4, 9-10, 15-20, 23-24, 29-30, and 35-40 are dependent claims, each of which depends (directly or indirectly) on one of the claims discussed above. Each of Claims 3-4, 9-10, 15-20, 23-24, 29-30, and 35-40 is therefore allowable for the reasons given above for the claim on which it depends. In addition, each of Claims 3-4, 9-10, 15-20, 23-24, 29-30, and 35-40 introduce one or more additional limitations that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

CONCLUSION


For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Christopher J. Brokaw
Reg. No. 45,620

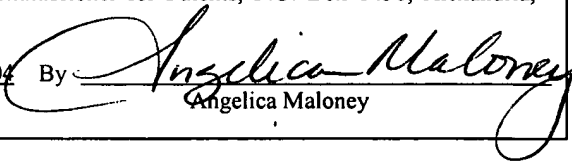
1600 Willow Street
San Jose, CA 95125
(408) 414-1080, ext. 225
Date: November 18, 2004
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop A mendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On November 18, 2004

By


Angelica Maloney